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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,794	01/19/2002	Dennis H. Harris	53002-1	4273

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JOSEPH W MOTT  
JENNINGS STROUSS & SALMON PLC  
201 EAST WASHINGTON STREET  
11TH FLOOR  
PHOENIX, AZ 85004-2385

EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 11/20/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/053,794

Applicant(s)

HARRIS ET AL.

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claim 10 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 3.
2. Applicant's election with traverse of invention group I, claims 1-9 in Paper No. 3 is acknowledged. The traversal is on the ground(s) that the cited method in the restriction requirement does not have the particular steps herein. This is not found persuasive because claimed process and the cited method are both for treating skin condition. They are the same in term of the functions, they are different in employing different materials.

The requirement is still deemed proper and is therefore made FINAL.

### *Claim Rejections 35 U.S.C. 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2 and 3 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims recite "polyvinol crystal" in the claimed composition. However, the specification or the claims do not provide proper written description regarding what is "polyvinol crystal," and how to obtain such material to practice the claimed invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 1-4 are directed to a composition comprising two phases. However, the specification indicates the claimed composition is actually consisting of two completely separated compositions. See pages 10-14 in the specification. The claim is indefinite as to the definition of the "composition." More specifically, is the composition a mixture of the two phases, or actually two separated composition?

8. Claims 2 and 3 recite phrase "polyvinol crystal." However, the claims or the specification provide no definition for the phrase. The claim are indefinite as the "polyvinol crystal encompassed thereby.

***Claim Rejections 35 U.S.C. 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. (6,444,647), in view of Albacarys et al. (6,338,855) Yokoyama et al. (6,419,962), Fuller (6,096,295) and Wenker (IDS) .

11. Robinson et al. teaches a skin care composition comprising humectant, e.g., glycerin, exfoliant, glycerin, circulatory enhancement agent nicotinic acid, antibacterial agents, such as methyl paraben, anti-inflammatory agent, such as salicylic acid, antioxidant, such as vitamin E

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derivatives. See, the examples in columns 37-42 and the claims. The composition may also contain other well-known skin care ingredients including various dermatological acceptable carrier, surfactant, structural materials, polymers, and dermatological acceptable active ingredients, such as aloe, pantothenic acids, vitamins etc. See, columns 22-34.

Robinson et al. does not teach expressly the particular combination herein, or the employment of yohimbine, or sorbital.

However, Fuller teaches that yohimbine is known to be useful for skin care composition. See, the abstract and the claims. Further, Albacarys et al., Yokoyama et al. and Wenker teaches that the particular ingredients employed herein are well-known dermatological acceptable ingredients. For examples, Wenker teaches Aloe vera gel is known to be useful in skin care composition. See the examples and the claims. Albacarys teaches that sage extract, methyl paraben, chamomile extract, are known active ingredients for skin care composition. See, particularly, column 18, line 7, column 19, lines 5-24, column 21, and lines 28-67. Yokoyama et al. teaches that extracts from natural products including sage extract, seaweed extract, are known to be useful in skin care products. See, particularly, column 5, lines 47-62. Further, sorbital, (sorbitan esters) is also a well known dermatological acceptable ingredients, See, column 7, line 66 bridging column 8, line 5.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make a skin care composition comprising two phases and each phase comprising the well-known dermatological acceptable ingredients, such as aloe vera gel, yohimbine, pantothenic acid, nicotinic acid, and sorbital and glycerin.

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A person of ordinary skill in the art would have been motivated to make a skin care composition comprising two phases and each phase comprising the well-known dermatological acceptable ingredients, such as aloe vera gel, yohimbine, pantothenic acid, nicotinic acid, and sorbital and glycerin because each and every ingredients are known to be useful in skin care composition, and are known to be useful in combination with other ingredients. It is prima facie obvious to combine two or more ingredients, each of which is taught in the prior art to be useful for same purpose in order to form a composition that is to be used for very the same purpose; idea of combining them flows logically from their having been individually taught in prior art; thus, the claimed invention which is a combination of well-known dermatological acceptable ingredients, sets forth prima facie obvious subject matter, absent evidence to the contrary. See In re Kerkhoven, 205 USPQ 1069. The optimization of a result effective parameter, e.g., particle formula of the composition (two phases), is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215. Note the intended function of each ingredient is not seen to further limit a claim drawn to a composition.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Examiner

A handwritten signature in black ink, appearing to be 'S. Wang' with a stylized flourish at the end.

Shengjun Wang

November 15, 2002